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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

06502.0371-00000

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on \_\_\_\_\_

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Typed or printed name \_\_\_\_\_

Application Number

10/035,746

Filed

12/28/2001

First Named Inventor

Guy L. Steele, Jr

Art Unit

2193

Examiner

Mai, Tan V.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record.

Registration number 56,249

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Signature

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Typed or printed name

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9/30/05  
Date

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**EXPEDITED PROCEDURE REQUESTED  
EXAMINING GROUP 2193  
PATENT  
Customer No. 22,852  
Attorney Docket No. 06502.0371-00**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Guy L. STEELE, Jr. ) Group Art Unit: 2193  
Application No.: 10/035,746 ) Examiner: Mai, Tan V.  
Filed: December 28, 2001 ) Confirmation No.: 4057  
For: CIRCUIT FOR SELECTIVELY )  
PROVIDING MAXIMUM OR )  
MINIMUM OF A PAIR OF )  
FLOATING POINT OPERANDS )

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant requests a pre-appeal brief review of the rejections in the Office Actions mailed on September 22, 2004, and May 31, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed August 29, 2005, which merely states "[t]he Examiner believes the rejections are proper" (Advisory Action at p. 1). None of the points raised by Applicant in the Request for Reconsideration mailed July 29, 2005 (hereafter "RFR") have been addressed by the Examiner.

Remarks begin on page 2 of this paper.

**REMARKS**

Claims 1-71 remain pending, with claims 1-28 being allowed and claims 29-71 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 29-71 under three separate 35 U.S.C. § 103(a) rejections: as unpatentable over U.S. Patent No. 5,995,991 to Huang et al. ("Huang"); as unpatentable over U.S. Patent No. 5,931,943 to Orup ("Orup"); and as unpatentable over U.S. Patent No. 6,009,511 to Lynch et al. ("Lynch"). The Examiner also rejected claims 29, 31, 59, and 60 under obviousness-type double patenting as being unpatentable over claims 11, 12, 14, 17, 18, and 20 in copending Application No. 10/035,586; and rejected claims 29, 31-34, 59, and 60 under obviousness-type double patenting as being unpatentable over claims 15, 17-20, 26, and 28 in copending Application No. 10/028,375.<sup>1</sup>

**I. The rejection of claims 29-71 under 35 U.S.C. § 103(a) as being unpatentable over Huang is improper**

The Examiner's rejection contains clear errors and omits essential elements necessary to establish a *prima facie* case of obviousness with respect to claims 29-71 based on *Huang*. *Huang* does not teach or suggest each and every element of Applicant's claims, and there is no motivation to modify *Huang*.

Claim 29 recites a combination including, for example,

determining a format of the first floating point operand based upon floating point status information encoded within the first floating point operand;

determining a format of the second floating point operand based upon floating point status information encoded within the second floating point operand.

The Examiner appears to assert that *Huang*'s register 116 (Fig. 4) constitutes the claimed "operand." This is clearly wrong.

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<sup>1</sup> Pending the withdrawal of the rejections under 35 U.S.C. § 103(a), Applicant will respond to the double patenting rejections as set forth in M.P.E.P. § 804(I)(B) or § 804.02. Applicant does not request review of these rejections by the Pre-Appeal Brief review board.

*Huang* specifically distinguishes between a register and an operand, stating “each of the **registers** 116 and 118 has an **operand** . . . portion 116-1 and 118-1.” (*Huang*, col. 6, line 66-col. 7, line 1). Moreover, “**operands X and Y** [are] stored in **operand portions** 116-1 and 118-1 of **registers 116 and 118**.” (*Huang*, col. 7, lines 8-10). Even assuming that tag values *x\_tag* and *y\_tag* correspond to the claimed “status information,” (which Applicant does not concede) the Examiner’s contention that *Huang*’s register 116 containing *x\_tag* 116-2 constitutes the claimed “status information encoded within the operand” is clearly contradicted by *Huang*. See, e.g., *RFR* at p. 10.

Structures such as those taught by *Huang* were acknowledged in the Background section of Applicant’s specification, which states “conditions are typically represented by flags [a form of status information] that are stored in the floating point status register, separate from the floating point operand” (paragraph 024, see also paragraph 003). Claim 29 specifically distinguishes over such structures, calling for “status information encoded within the ... operand.” See, e.g., Fig. 2, paragraph 047, and paragraph 048 of Applicant’s specification.

Accordingly, the Examiner’s position that *Huang*’s register 116 constitutes an “operand,” as recited in the claims, is a clear error. The separate operand 116-1 and separate tag value 116-2 do not constitute a teaching or suggestion of “status information encoded within the ... operand,” as recited by claims 29 and 59 and required by dependent claims 30-58 and 60-71. Since *Huang* fails to teach each and every element of the claims, the rejection of claims 29-71 under 35 U.S.C. § 103(a) is improper. Applicant requests that the rejection be withdrawn.

Moreover, the Examiner has neither indicated how *Huang* could be modified nor provided any motivation to modify *Huang* to achieve the claimed combination (see *RFR* at

p. 11, paragraph 3, p. 12, paragraph 1 and Office Action mailed September 22, 2004 at p. 6). Therefore, no *prima facie* case of obviousness has been established for claims 29 and 59. Similar reasoning applies to dependent claims 30, 32-58, and 60-71 (see *RFR* at p. 12 and Office Action mailed September 22, 2004 at p. 7).

Therefore, the rejection of claims 29-71 under 35 U.S.C. § 103(a) based on *Huang* is improper and Applicant requests that the rejection be withdrawn.

**II. The rejections of claims 29-71 under 35 U.S.C. § 103(a) as being unpatentable over *Orup* and *Lynch* are improper**

The Examiner's rejections contain clear errors and omit essential elements necessary to establish a *prima facie* case of obviousness of Applicant's claims 29-71 based on *Orup* or *Lynch*. Similar to the discussion of *Huang* above, neither *Orup* nor *Lynch* teach or suggest "status information encoded within the ... operand," as recited by claim 29.

*Orup* and *Lynch* have a common assignee, and *Orup* includes much of the specification of *Lynch*. Applicant will therefore discuss *Orup* and *Lynch* together.

The rejection does not make clear what portion(s) of *Orup* and *Lynch* allegedly teach the claimed "status information." However, even assuming that *Orup*'s and *Lynch*'s tag value constitutes "status information," (which Applicant does not concede) the tag value of *Orup* and *Lynch* is not "encoded within the ... operand," as recited by claim 29.

The Examiner appears to assert that *Orup*'s and *Lynch*'s element 84 (Fig. 4) constitutes an "operand" which contains tag field 89 (alleged status information). See Office Action mailed September 22, 2004 at pp. 4-5 and 7-8. This is incorrect. *Orup* and *Lynch* specifically state that element 84 is a register stack, not an operand, and that register stack 84 contains a separate Reg Field 87 for storing an operand and a separate Tag Field 89 for storing a tag (alleged status information). *Orup* and *Lynch* only teach that the tag is

associated with, but separate from an operand; not that the tag is encoded within an operand (see *RFR* at p. 4, pp. 15-16). Fig. 4 of *Orup* and *Lynch* clearly illustrate that Tag Field 89 (status information) and Reg Field 87 (operand) are separate from each other and stored within register stack 84. This does not constitute a teaching or suggestion of “status information encoded within the ... operand,” as recited by independent claims 29 and 59 and required by dependent claims 30-58 and 60-71.

Moreover, the Examiner has neither indicated how *Orup* or *Lynch* could be modified nor provided any motivation to modify *Orup* or *Lynch* to achieve the claimed combination (see *RFR* at p. 5, 6, and 17; see Office Action mailed September 22, 2004 at p. 5 and 8). Therefore, no *prima facie* case of obviousness has been established for claims 29 and 59. Similar arguments apply to dependent claims 30, 32-58, and 61-71 (see *RFR* at pp. 6-7, 18, and see Office Action mailed September 22, 2004 at pp. 6 and 8-9).

Therefore, the rejections of claims 29-71 under 35 U.S.C. § 103(a) based on *Orup* and *Lynch* are improper. Applicant requests the board of examiners to withdraw these rejections.

In view of the foregoing, claims 1-71 are in condition for allowance pending the withdrawal of the double patenting rejections. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005

By: Nathan A. Sloan  
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